

Attorney Docket No. TS6632/US

REMARKS/ARGUMENTS**Objection To The Disclosure Under 37 C.F.R. § 1.71**

The Examiner has objected to the disclosure of the present application under 37 C.F.R. § 1.71 as being so incomprehensible as to preclude a reasonable search of the prior art by the Examiner. The Examiner notes by way of the examples on page 3, lines 12 and 26; page 4, line 9; page 9, Table 1; and page 20, line 30, that the phrase "Step I MW" is recited without proper definition or disclosure for this terminology.

Applicants maintain that the application is not incomprehensible and that the phrase "Step I MW" is a term that those skilled in the art would readily understand. 37 C.F.R. § 1.71 provides in subparagraph (a) that: "[t]he specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same." Applicants maintain that this requirement has been met with regard to the present application. Within the specification, Applicants use the phrase "Step I molecular weight (MW)" with regard to the poly(styrene-butadiene-styrene) polymer. Applicants note that the step I molecular weight for this polymer is between 9,000 and 10,000 kg/mol. Those skilled in the art will recognize that the phrase "step I" refers to the primary step in making the polymer claimed. Accordingly, for a polymer that is poly(styrene-butadiene-styrene) (as in the present case), this would mean the preparation of the first styrene block. As noted on page 4, lines 29 to 33, the polymer of the present invention may be made using a difunctional coupling agent or it may be full sequential. In either case, in order to prepare the polymer noted above, the first step (step I) is to prepare a styrene block. The second step (step II) in the preparation is to add butadiene to react with the styrene block. In the case of the full sequential block copolymer, the third step (step III) is carried out by adding additional styrene to form the third block. In the case of the coupled block copolymer, the third step (step III) is actually the addition of the coupling agent to couple the arms that have been prepared in the first and second steps. In any event, the preparation of each

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polymer comprises a series of steps which occur in a specific order, said steps being known in the art. Therefore, Applicants maintain that those skilled in the art would readily understand that when the molecular weight of step I is given in the case of a poly(styrene-butadiene-styrene) polymer, this molecular weight references the molecular weight of the beginning or "step I" styrene block.

In view of the above, Applicants respectfully request that the objection to the application be withdrawn in view of the above comments.

Rejection Under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected Claims 11 to 28 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. The Examiner has noted that the phrase "Step I MW" in claim 11 and claims 21 to 23 renders the claims indefinite because "Step I MW" is unclear. This rejection is respectfully traversed with regard to Claims 11 to 28.

35 U.S.C. § 112, second paragraph, provides that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." As noted in the MPEP, "the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. § 112, second paragraph, by providing clear warning to others as to what constitutes infringement of a patent. MPEP, Section 2173.02, Clarity and Precision, citing, Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). The MPEP further notes that the test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification". Id., citing, Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). Applicants maintain that those skilled in the art would understand what is being claimed with regard to the phrase "step I molecular weight" when said claims are being read in light of the specification.

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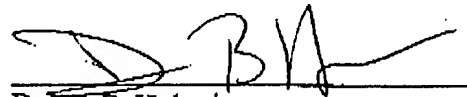
More specifically, the issue is whether one skilled in the art would understand the metes and bounds of the polymer claimed in view of the specification and the parameters of the claims. Applicants maintain that they would. As noted in remarks to the objection above, those skilled in the art will recognize that the phrase "step I" refers to the primary step in making the polymer claimed. Accordingly, for a polymer that is poly(styrene-butadiene-styrene) (as in the present case), this would mean the preparation of the first styrene block. The remaining steps are described in detail above in the response to the objection. As further noted above, the preparation of each polymer comprises a series of steps which occur in a specific order, said steps being known in the art. Therefore, Applicants maintain that those skilled in the art would readily understand that when the molecular weight of step I is given in the case of a poly(styrene-butadiene-styrene) polymer, this molecular weight references the molecular weight of the beginning or "step I" styrene block.

In view of the above, Applicants maintain that Claims 11 to 28 are not indefinite under 35 U.S.C. § 112, second paragraph, and respectfully request that this rejection be withdrawn.

Applicants respectfully request that in view of the above, the search of the application be conducted. Allowance of the claims is earnestly solicited.

Respectfully submitted,

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Donna B. Holguin
Registration Number 38,082
KRATON Polymers U.S. LLC
3333 Highway 6 South, Rm. CA-108
Houston, Texas 77082
281-668-3224 (Phone)
281-668-3155 (Fax)